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In re application of : **Confirmation No. 2630**
Kanji HATA et al. : Docket No. 2002_0244
Serial No. 10/079,494 : Group Art Unit 3729
Filed February 22, 2002 : Examiner Donghai Nguyen

COMPONENT MOUNTING APPARATUS
AND METHOD

PETITION TO WITHDRAW RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

Sir:

In view of the following, it is hereby petitioned that the Restriction Requirement as expressed in the Office Action mailed February 18, 2005, and repeated in the Office Action mailed June 21, 2005, be withdrawn.

FACTS

The application as filed included apparatus claims 1-20 and method claims 21-24.

In the Office Action mailed March 1, 2004, the Examiner restricted apparatus claims 1-20 from method claims 21-24 (first restriction requirement).

In reply to this first restriction requirement, Applicants elected claims 1-20 by way of the response filed March 26, 2004.

A non-final Office Action was mailed June 3, 2004.

In reply to this non-final Office Action, a response was filed December 2, 2004. By way of this response, apparatus claims 1-13 were amended, claims 14-24 were cancelled, new apparatus claims 25-32, 47-50 and 55-58 were added, and new method claims 33-46, 51-54, 59 and 60 were added.

In the Office Action mailed February 18, 2005, the Examiner restricted Group I apparatus claims 1-13, 25-32, 47-50 and 55-58 from Group II method claims 33-46, 51-54, 59 and 60 (second restriction requirement).

On April 14, 2005, reconsideration of this second restriction requirement was requested via a traversal of the restriction requirement.

On June 21, 2005, an Advisory Action was mailed providing an explanation as to why this request for reconsideration was not persuasive to have the second restriction requirement withdrawn.

DISCUSSION

MPEP 806.05(e) states that a process and apparatus for its practice can be shown to be distinct inventions such that restriction is proper if

the process *as claimed* can be practiced by another or materially different apparatus or by hand; or the apparatus *as claimed* can be used to practice another and materially different process.

In the Office Action mailed February 18, 2005, the basis for the second restriction requirement between the method claims and the apparatus claims was stated as

the method as claimed can be practiced by another and materially different apparatus having only a first mounting head section.

This reason is not sufficient to support the second restriction requirement.

In this regard, each of independent method claims 33 and 36 requires "providing ... a first mounting head section ... and a second mounting head section". This "providing" step is a positive method limitation. Accordingly, because these claims require provision of two mounting head sections, the method as claimed cannot be practiced by an apparatus including only one mounting head section, even though claims 33 and 36 recite that only one of the mounting heads is used.

Additionally, assuming *arguendo* that the restriction requirement between method claims 33 and 36 and the apparatus claims is proper, dependent method claims 35 and 38, which depend from claims 33 and 36, respectively, require use of the second mounting head section, whereby the restriction requirement between claims 35 and 38 and the apparatus claims is not proper. And, since claims 35 and 38 cannot be restricted from claims 33 and 36, respectively, claims 33-38, 51 and 52 are not restrictable from the apparatus claims. Similarly, because independent method claims 39 and 43 are not restrictable from method claims 33-38, method claims 39-46, 53, 54, 59 and 60 are also not restrictable from the apparatus claims.

In the Advisory Action mailed June 21, 2005, the Examiner maintained support of the second restriction requirement for the reasons as expressed in the Office Action mailed February 18, 2005, and provided an additional reason that the step of "positioning the first mounting head..." can be practiced manually or by hand.

This additional reason is also not sufficient to support the second restriction requirement.

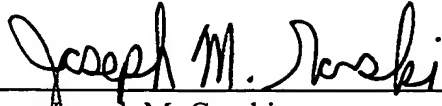
In this regard, MPEP 806.05(e) states that restriction is proper if the method **as claimed** can be practiced by hand. That one step of the claimed method can arguably be manually performed does not demonstrate that the method in its entirety can be practiced by hand.

The method **as claimed** requires the specific structure of the apparatus **as claimed**, and the apparatus **as claimed** recites that the apparatus is to be operated so as to perform the method **as claimed**. Accordingly, the one-way distinctness necessary for restriction between method and apparatus claims does not exist with regard to the currently pending claims.

In view of the above, it is respectfully submitted that the second restriction requirement is improper and should be withdrawn.

Respectfully submitted,

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